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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of

Applicants : Phelps et al.
Serial No. : 10/625,886
Filed : July 23, 2003
Title : NON-TOXIC CORROSION-PROTECTION RINSES AND SEALS
BASED ON RARE EARTH ELEMENTS
Docket : UVD 0299 IA / UD 268
Examiner : Zheng, L.
Art Unit : 1742
Confirmation No. :

Commissioner for Patents
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Patricia L. Prior
Patricia L. Prior - Attorney Reg. No. 33,758

Sir:

RESPONSE TO RESTRICTION/ELECTION REQUIREMENT

This paper is being filed in response to the Office Action mailed on September 29, 2005.

In the Office Action, the Examiner required restriction between allegedly distinct inventions identified by the Examiner as Group I (claims 1-55, and 137), said to be drawn to a corrosion-inhibiting seal; Group II (claims 56-90 and 138), said to be drawn to a method of making a corrosion inhibiting sealing bath; and Group III (claims 91-136 and 139), said to be drawn to a method of applying a corrosion inhibiting sealing bath. Applicants elect Group I (claims 1-55 and 137) without traverse.

Applicants note that Group III is drawn to a method of applying a corrosion-inhibiting seal, rather than a method of applying a corrosion-inhibiting sealing bath.

Claims 9-29 are said to be generic to a plurality of disclosed patentably distinct species comprising inorganic valence stabilizers and organic valence stabilizers. Applicants

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provisionally elect, with traverse, inorganic valence stabilizers, claims 9-11, for initial prosecution on the merits. Applicants respectfully traverse the present species election requirement because upon the allowance of a generic claim, applicants will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim. *See* 37 CFR §1.141.

Claims 36-40 are said to be generic to a plurality of disclosed patentably distinct species comprising cationic solubility control agents and anionic solubility control agents. Applicants provisionally elect, with traverse, cationic solubility control agents, claims 36-38, for initial prosecution on the merits. Applicants respectfully traverse the present species election requirement because upon the allowance of a generic claim, applicants will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim. *See* 37 CFR §1.141.

Claims 46-49 and 51-52 are said to be generic to a plurality of disclosed patentably distinct species comprising active UV blockers, passive UV blockers, brighteners, an agent which prevents smudging, and a wetting agent. Applicant notes that there are no wetting agents in claims 46-49 and 51-52. Applicants provisionally elect, with traverse, active UV blockers, claims 46-47, for initial prosecution on the merits. Applicants respectfully traverse the present species election requirement because upon the allowance of a generic claim, applicants will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim. *See* 37 CFR §1.141.

Claims 56, 58, 64-66, and 138 are said to be generic to a plurality of disclosed patentably distinct species comprising cerium sources, praseodymium sources, and terbium sources. Applicants provisionally elect, with traverse, cerium sources, claims 56, 58, 64, and 138, for initial prosecution on the merits. Applicants respectfully traverse the present species election requirement because upon the allowance of a generic claim, applicants will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim. *See* 37 CFR §1.141.

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Claims 69-73 and 82-83 are said to be generic to a plurality of disclosed patentably distinct species comprising fluorides, chlorides, bromides, acidic species, and hydroxides. Applicants provisionally elect, with traverse, fluorides, claims 69-71 and 82, for initial prosecution on the merits. Applicants respectfully traverse the present species election requirement because upon the allowance of a generic claim, applicants will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim. *See* 37 CFR §1.141.

Claims 75-79 are said to be generic to a plurality of disclosed patentably distinct species comprising cationic solubility control agents and anionic solubility control agents. Applicants provisionally elect, with traverse, cationic solubility control agents, claims 75-77, for initial prosecution on the merits. Applicants respectfully traverse the present species election requirement because upon the allowance of a generic claim, applicants will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim. *See* 37 CFR §1.141.

Claims 91, 97, 105-107, and 108 are said to be generic to a plurality of disclosed patentably distinct species comprising cerium sources, praseodymium sources, and terbium sources. It is believed that citation of claim 108 is in error because it recites the valence stabilizer, and that claim 139 was intended. Applicants provisionally elect, with traverse, cerium sources, claims 91, 97, 105, and 139, for initial prosecution on the merits. Applicants respectfully traverse the present species election requirement because upon the allowance of a generic claim, applicants will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim. *See* 37 CFR §1.141.

Claims 112-116, and 128-129 are said to be generic to a plurality of disclosed patentably distinct species comprising fluorides, chlorides, bromides, acidic species and hydroxides. Applicants provisionally elect, with traverse, fluorides, claims 112-114, and 128, for initial prosecution on the merits. Applicants respectfully traverse the present species election

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requirement because upon the allowance of a generic claim, applicants will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim. *See* 37 CFR §1.141.

Claims 121-125 are said to be generic to a plurality of disclosed patentably distinct species comprising cationic solubility control agents and anionic solubility control agents. Applicants provisionally elect, with traverse, cationic solubility control agents, claims 121-123, for initial prosecution on the merits. Applicants respectfully traverse the present species election requirement because upon the allowance of a generic claim, applicants will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim. *See* 37 CFR §1.141.

Applicants have elected species for each of the species elections in the belief that is what the examiner was seeking. In the event that the examiner wanted only a single election, Applicants provisionally elect, with traverse, inorganic valence stabilizers, claims 9-11, for initial prosecution on the merits. Applicants respectfully traverse the present species election requirement because upon the allowance of a generic claim, applicants will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim. *See* 37 CFR §1.141.

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Applicants respectfully submit that the application is in condition for allowance. The Examiner is encouraged to contact the undersigned to resolve efficiently any formal matters or to discuss any aspects of the application or of this response. Otherwise, early notification of allowable subject matter is respectfully solicited.

Respectfully submitted,

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